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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,201	06/25/2003	Tammy Burd Mehta	100/05231	4356
21569 7590 10/03/2008 CARDINAL LAW GROUP Caliper Life Sciences, Inc. 1603 Orrington Avenue, Suite 2000 Evanston, IL 60201				
EXAMINER				
GROSS, CHRISTOPHER M				
ART UNIT		PAPER NUMBER		
1639				
MAIL DATE		DELIVERY MODE		
10/03/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/606,201

**Applicant(s)**

BURD MEHTA ET AL.

**Examiner**

CHRISTOPHER M. GROSS

**Art Unit**

1639

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 4-6 and 12-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-11, 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

Responsive to communications entered 6/26/2008. Claims 1-20 are pending. Claims 4-6, 12-16 are withdrawn. Claims 1-3, 7-11, 17-20 are under consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Priority***

This application was filed on 6/25/2003.

This application is a CON of 09/510,626 02/22/2000 (now PAT 6,632,655)

which claims benefit of 60/121,223 02/23/1999

and claims benefit of 60/127,825 04/05/1999

and claims benefit of 60/128,643 04/09/1999

#### ***Withdrawn Objection(s) and/or Rejection(s)***

The rejection of claims 1-3, 7-11, and 17-20 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement concerning new matter is hereby withdrawn in view of applicant's persuasive arguments.

#### ***Maintained Claim Rejection(s) - 35 USC § 102***

Claims 1-3, 7, 8-11, and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Parce et al. (US Patent 5,942,443; *filing date of 06/28/1996*; referred to as '443)

Claims 1-3, 7, 8-11, and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Parce et al. (US Patent 6,429,025 B1; *filing date of 03/19/1998*).

*Response to Arguments*

In the response entered 6/26/2008, applicant argues not all elements are taught.

Applicant's arguments have been fully considered but they are not deemed persuasive for the following reasons.

Specifically, applicant argues, see p 7-8, Parce et al do not teach the narrow channels *extending in the same direction* as the broad channel. In this vein, applicant alleges figure 4 of the present application shows, unlike Parce et al, narrow channel elements 4045 and 4050 extend in the same direction as broad channel element 4060 and 4070.

Herein the examiner respectfully notes, save the particle retention zone(s) (e.g. element 344), the cross-section of the microfluidic device according to Parce et al in figure 4a of '443, is virtually identical to the cross-section shown in figure 4b of the present application. And further, the examiner notes figure 4a of Parce et al illustrates the narrow channels (reaction channels; elements 312,314) are extended in local width to provide bead resting wells (e.g. elements 326,328) in the same direction as the broad channel (sample injection channel; element 340). See also 35 USC 112 second paragraph concerns below.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the **second** paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 7, 8-11, and 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

*This rejection is necessitated by Applicant's amendment to the claims.*

Claims 1-3, 7, 8-11, and 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships concern the narrow and broad channel extending in the same direction.

Specifically, the direction with which the narrow and broad channels extend is not defined thus it may be interpreted as any of width, depth or length, and each dimension with respect to each channel individually (local) or with respect to the microfluidic device as a whole (global).

The phrase "same direction" in claims 1 and 17 is a relative term which renders the claim indefinite. The phrase "same direction" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In particular, applicant has not set forth a coordinate system (local or global width, depth or length) required to ascertain the meaning of "same direction."

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Gross whose telephone number is (571)272-4446. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Douglas Schultz can be reached on 571 272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher M Gross  
Examiner  
Art Unit 1639

cg

/JD Schultz, PhD/  
Supervisory Patent Examiner, Art Unit 1635